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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,862	04/22/1999	HIROYUKI KURIYAMA	500.37156XOO	2908

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EXAMINER

BEX, PATRICIA K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 06/27/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-14

**Office Action Summary**

Application No.

09/284,862

Applicant(s)

KURIYAMA ET AL.

Examiner

P. Kathryn Bex

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,6,10 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,10 and 12-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on April 14, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/284862 is acceptable and a CPA has been established. An action on the CPA follows.
2. The cancellation of claims 9 and 11 is acknowledged and has been entered into the record.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1, 3, 5-~~6~~, 10, 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakatake (USP 5,380,488) in view of Onuma *et al* (JP 10-253635).

Wakatake anticipate the instant claims by teaching an modular analyzer system comprising a specimen rack 2, a specimen introducing part Y1, a specimen rack conveying parts

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10, 15, 25, a storage part for storing the specimen, three analyzers D1-D3, wherein the introducing part, the storage part Y4 and the analyzers are independent of each other (column 2, line 61-62), the analyzers each comprising pipette assembly (column 3, lines 35-65) and allowing the specimen to react with a reagent. The specimen introducing part, analyzers and storage parts are arranged and couple along the longitudinal direction of the conveyers (Fig1). Wakatake teach that it is possible to provide a plurality of analyzers for performing a first item of analysis and a plurality of other analyzers for performing a second time of analysis (column 6, line 65- column 7, line 10). Note: Wakatake teach a reexamining buffer for temporarily holding a specimen after analysis is complete. Additionally, Wakatake teaches that each analyzer includes a take-in buffer, a specimen rack discharge part (column 3, line 66- column 4, line 3). It is inherent within the "modular" system of Wakatake that the independent units are equal in height and depth, so that it is possible to avoid the high cost that would arise from special ordering an entire analyzing system. This allows for versatility of the system by incorporating as many analyzers as needed to meet the scale of delivery desired (column 6, lines 55-62).

Wakatake does not disclose the use of identification means which are projected from the front surfaces of the analyzing units and have colors different from each other. However, JP 62-1603 does teach the use of a function identification means 31-32 (Fig. 4b) on the front of analyzers 21 (Fig. 9). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include in on the units of Wakatake an identification and pattern on the front of a modular unit, as taught by Onuma *et al*, in order to identify analysis procedure of the units without having to open the cover of the equipment. Moreover, it has been held that matters relating to ornamentation, (i.e. shape and color) only which have no mechanical

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function cannot be relied upon to patentably distinguish the claimed invention from the prior art.). But see MPEP 2144.04 (I) and *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

With respect to the specific heights and depths of the units recited in claims 5 and 12, one of ordinary skill in the art would have found it obvious to have provided the modular units of Wakatake with a particular height and depth, in order to optimize the ability of the average observer to work at the units. Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

5. Claims 1, 3, 5-~~6~~, 10, 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi *et al* (USP 6,337,050 B1).

Takahashi *et al* teach a modular analyzer system comprising a specimen rack 10, a specimen introducing part 50, a specimen rack conveyor 30 positioned longitudinally along the plurality of removable analyzers, i.e. buffer, centrifuge, destoppler, etc. 2a-b, 3-9 (Fig. 1, 4ab-c, 5-7f). Additionally, each analyzer comprising a take-in buffer and discharge part 24-29 and a storage part for storing the specimen rack. The modular system comprising identification parts 16 at intervals equal to the length of the specimen rack (Fig. 6). Note: Takahashi *et al* teach stages 65 on the top surface the analyzing units (Fig. 3). Takahashi *et al* teach the adjustment of the various modular components via height adjusting screws 71. Additionally, Takahashi *et al* do teach modular components 50, 5a-b8-9 and 60 having the same widths, i.e. A (Fig. 2).

Takahashi *et al* do not disclose the identification means 16 which project from the front surfaces of the analyzing units and have colors different from each other. However, it would

have been obvious to one of ordinary skill in the art to include in on the units of Takahashi *et al* different colored identification means which project from the front surfaces of the analyzing units in order to identify analysis procedure of the units without having to open the cover of the equipment. Moreover, it has been held that matters relating to ornamentation only (i.e. shape and color), and which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.). But see MPEP 2144.04 (I) and *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

Takahashi *et al* do not teach the specific widths of the rack conveying part, specimen introducing part, analyzing part and specimen storage parts having heights within the range of 850-950 mm as measured from the floor surface, as recited in claims 5 and 12. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have adjusted the height of the modular components of Takahashi *et al* with a particular height and depth, in order to optimize the ability of the average observer to work at the units. Additionally, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1, 3, 5-6, 10, 12-17 have been considered but are moot in view of the new ground(s) of rejection. See above Office Action.

### ***Conclusion***

7. No claims allowed.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays, alternate Fridays from 6:00 am to 3:30 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 308-4037.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9310 for official papers prior to mailing of a Final Office Action. For after-Final Office Actions use (703) 872-9311. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

*Kathryn Bex*

P. Kathryn Bex  
Patent Examiner  
AU 1743  
June 21, 2002

*Jill Warden*  
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